

Notice of Allowability

Application No.

09/981,664

Examiner

Herng-der Day

Applicant(s)

DEBLING, ANTHONY

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2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendments received 7/14/05 and 10/14/05.
2. ☒ The allowed claim(s) is/are 1 and 3-12, now renumbered as 1-11.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


KAMINI SHAH
Supervising PRIMARY EXAMINER
A.V. 2128

DETAILED ACTION

1. This communication is in response to Applicant's Amendment to Office Action dated February 25, 2005, mailed July 12, 2005, received by PTO July 14, 2005, and Applicant's Supplemental Response faxed October 14, 2005.

1-1. Claims 1, 3, 6, 9, and 11 have been amended. Claim 2 has been cancelled. Claims 1 and 3-12 are pending.

1-2. Claims 1 and 3-12 have been examined and allowed.

Reasons for Allowance

2. The following is an Examiner's statement of reasons for allowance:

2-1. The closest prior art of record discloses:

(1) An interface device, which enables communications between devices having disparate protocols (e.g., USB and Ethernet), and can be fabricated on a single IC chip (Silverman et al., U.S. Patent 6,370,603 B1).

(2) A system fabricated on a single IC chip includes functional blocks of Ethernet and USB (Klaas, U.S. Patent 6,816,750 B1);

(3) Automatic detection of connectivity between an emulator and a target device (Swoboda, U.S. Patent Application Publication 2002/0059541 A1).

2-2. The prior art does not expressly teach or render obvious the invention as recited in independent claims 1, 3, 6, 8, 9, and 11.

The use of an interface device fabricated on a single IC chip, which enables communications between devices having disparate USB and Ethernet protocols, was uncovered in the prior art. However, the use of the interface device to debug or communicate with a target integrated circuit chip having a digital processor, an on-chip emulator, and a target on-chip universal serial bus interface connected to the on-chip emulator, in the context of the claims, was not uncovered in the prior art teachings.

The limitations directed to the specific environment including a target integrated circuit chip having a digital processor, an on-chip emulator for controlling the digital processor and for collecting operation data from the digital processor for communicating to off-chip circuitry or host, and a target on-chip universal serial bus interface connected to the on-chip emulator as recited in preambles of claims 1, 3, 8, 9, and 11 are accorded patentable weight as they recite and provide limitations are required for completeness of the claims. The courts have held that “[A] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Further, “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference)

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between the claimed invention and the prior art. If so, the recitation serves to limit the claim.

See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Moreover, as the courts have held that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Nor was a reference uncovered that would have provided a basis of evidence for asserting a motivation that one of ordinary skill in the art at the time the invention was made, knowing of this specific environment, would have applied the interface device and modified a target integrated circuit chip to have a target on-chip universal serial bus interface connected to the on-chip emulator as recited in the context of the independent claims.

Dependent claims are allowed as they depend upon allowable independent claims.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

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Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day
October 17, 2005

H.D.

Kamini Shah
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Supervisory PRIMARY EXAMINER
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